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Docket No.: J2167.0125/P125

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Andrea Concannon et al.

Application No.: 09/438,590

Confirmation No.: 9576

Filed: November 12, 1999

Art Unit: 3628

For: BULK FILE SYSTEM USING EDI

Examiner: J. C. Pwu

**APPELLANTS' BRIEF**

U.S. Patent and Trademark Office  
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Dear Sir:

This brief is in furtherance of the Notice of Appeal, filed in this case on  
June 1, 2004.

You are hereby authorized to charge our credit card for the fee of \$340.00  
required under Section 1.17(f). PTO Form 2038 is attached.

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CONTINGENT EXTENSION REQUEST

If this communication is filed after the shortened statutory time period had elapsed and no separate Petition is enclosed, the Commissioner of Patents and Trademarks is petitioned, under 37 C.F.R. §1.136(a), to extend the time for filing a response to the outstanding Office Action by the number of months which will avoid abandonment under 37 C.F.R. § 1.135. The fee under 37 C.F.R. § 1.17 should be charged to our Deposit Account No. 50-2215.

This brief is transmitted in triplicate.

This brief contains items under the following headings as required by 37 C.F.R. § 1.192 and M.P.E.P. § 1206:

- I. Real Party In Interest
- II Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Invention
- VI. Issues
- VII. Grouping of Claims
- VIII. Arguments
- IX. Claims Involved in the Appeal
- Appendix A Claims

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

The Chase Manhattan Bank

## II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

## III. STATUS OF CLAIMS

### A. Total Number of Claims in Application

There are 13 claims pending in application.

### B. Current Status of Claims

1. Claims canceled: None.
2. Claims withdrawn from consideration but not canceled: None.
3. Claims pending: 1-13.
4. Claims allowed: None.
5. Claims rejected: 1-13.

### C. Claims On Appeal

The claims on appeal are claims 1-13.

## IV. STATUS OF AMENDMENTS

Applicants filed a Response To Final Rejection on June 1, 2004, arguing the patentability of the pending claims. The Examiner responded to the Response To Final Rejection in an Advisory Action mailed July 14, 2004. In the Advisory

Action, the Examiner entered the Response to Final Rejection but indicated that Applicants' arguments were "not deemed to place the application in condition for allowance." Advisory Action at 2. No further guidance was given in the Advisory Action.

Applicants have not amended the claims in the present application in light of any of the Examiner's rejections. Accordingly, the claims enclosed herein as Appendix A are the same as those originally filed in this application.

## V. SUMMARY OF INVENTION

The present invention relates to a system and method allowing customers of a banking institution to transmit bulk files of payment instructions to the bank for execution. Abstract. The bulk files contain a plurality of fund transfer transactions. Page 6, line 3, et seq. A first processor unbundles the single bulk file and groups the fund transfer transactions into two types, a first group requiring foreign exchange and a second group consisting of those transactions not requiring foreign exchange. Page 8, line 3, et seq. These transactions, once unbundled, are then passed onto the appropriate separate processor for processing. Page 8, line 24, et seq.

The system includes a funds transfer processor and a trading processor. The trading processor receives the foreign exchange funds transfer transactions and executes a foreign exchange operation in response to the received funds transfer transaction. Id.

According to the present invention, the customer is able to aggregate all of their transactions into a single message. Thus, a customer does not have to prepare and transmit a separate message for each transaction. Further, the financial institution receives a bulk file in place of single transaction instructions. Thus, the financial institution only has to acknowledge the receipt of a single file in place of acknowledging each separate funds transfer instruction. Page 3, line 14, et seq.

## VI. ISSUES

Are the Group I claims patentable over U.S. Patent No. 5,787,402 (“Potter”)?

## VII. GROUPING OF CLAIMS

For purposes of this appeal brief only, and without conceding the teachings of any prior art reference, the claims have been grouped as indicated below:

Group Claim(s)

I. 1-13

In Section VIII below, Applicant has included arguments supporting the separate patentability of each claim group as required by M.P.E.P. § 1206.

## VIII. ARGUMENTS

1. Are the Group I claims patentable over Potter?

In the final Office Action dated December 1, 2003, the Examiner issued a final rejection of claims 1-13 under 35 U.S.C. § 102(b) as being anticipated by Potter. However, the Potter reference fails to disclose Applicants' claimed invention. Applicants will address the arguments herein to independent claims 1 and 6 as dependent claims 2-5 and 7-13 include all of the limitations of the independent base claims from which they depend, which claims are allowable as discussed below.

#### A. Anticipation

With regard to the Examiner's rejection under 35 U.S.C. § 102, Appellants submit that this rejection is improper because the Examiner failed to establish a prima facie case of anticipation based on the Potter reference.

To anticipate a claim under 35 U.S.C. § 102, the cited reference must disclose every element of the claim, as arranged in the claim, and in sufficient detail to enable one skilled in the art to make and use the anticipated subject matter. See, PPG Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566 (Fed. Cir. 1996); C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1349 (Fed. Cir. 1998); M.P.E.P. § 2131, citing, Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."). A reference that does not expressly disclose all of the elements of a claimed invention cannot anticipate unless all of the undisclosed elements are inherently present in the reference. See, Continental Can Co. USA v. Monsanto Co., 942 F.2d 1264, 1268 (Fed. Cir.

1991). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

### B. Argument

Independent claims 1 and 6 both require receiving a bulk file “containing a plurality of funds transfer transactions.” The transactions in the bulk file are separated into two groups, a first group of transactions “not requiring a foreign exchange operation” and a second group of transactions “requiring a foreign exchange operation.” The grouping of the funds into the two groups takes place in the claimed first processor in claim 1 that recites the system for processing funds, whereas claim 6 recites a method for processing those fund transfer transactions.

The structure and process of Potter does not read on the first processor as recited in independent claim 1 or the grouping step recited in claim 6. Potter fails to disclose separating the transactions into those requiring foreign exchange operations and those that do not. The FX Order Server in Potter merely tracks leave orders to be executed by the FX Trade Server. The Payment Order Server in Potter handles bank-to-bank transfers and allows for the creation of an FX transaction out of a foreign payment.

The Final Office Action asserted that the above limitations are disclosed in column 5 of Potter. Specifically, the Final Office Action asserted that “[t]he FX Order Server provides for varying degrees of automatic and manual leave orders and uses the Rate Server to track and match a leave order’s desired rate.” Potter column

5, lines 15-20. However, this disclosure in Potter does not teach that the system in Potter is able to group or separate the orders requiring foreign exchange from the orders not requiring foreign exchange. Quite to the contrary, this section of Potter assumes that the Potter system is dealing solely with transactions of a single type, i.e., those that require foreign exchange.

In Potter, the client initiates a single type of transaction that is executed by a single application in Potter's system. The single application initiated by the client is the FX Trade, Money Market, FX Order, or Payment Order application. Fig. 4, step 222. The application is initiated by the client by selecting the appropriate program group. Potter, column 5, lines 60-63; Fig. 1. The user can only select a single application in which orders can be entered. As such, all of the orders that are entered by the customer are all of the same type, i.e., requiring foreign exchange or not. Therefore, there is no requirement in Potter, and therefore no ability, to group fund transfer transactions requiring a foreign exchange operation and those fund transfer transactions that do not require a foreign exchange operation. Thus, contrary to the Examiner's position, Potter does not inherently disclose grouping transactions requiring a foreign exchange operation and those that do not.

As discussed above, the incoming orders in the Potter system are only a single type of order. Potter's Payment Order Server receives the incoming orders via either the Society for Worldwide Interbank Financial Telecommunication (SWIFT) Agent Server 122 or the Batch File Transfer Server via direct interactive log-in by a Payment Order Server user 116. Col. 5, lns. 25-36. The files from the Batch File Transfer Server are the individual, same type orders, entered by the user in the single



application. Thus, the Batch File Transfer Server does not group the files by those requiring foreign exchange and those that do not require foreign exchange as explicitly recited in the pending claims.

The Potter reference does state that its Payment Order Server has to “break incoming payment orders down into their individual components,” i.e., transaction data and routing or header data, because the money orders are received in either Society for Worldwide Interbank Financial Telecommunications (SWIFT) format or directly from the Batch File Transfer Server. However, this function is not the grouping recited in the pending claims. The Payment Order Server breaks down these files into the individual requested transactions by removing the transaction data from the other information such as the routing information for the order. Thus, the “breaking incoming order payments down” is not the recited grouping in the pending claims.

The FX Order Server (102) handles the tracking of individual leave orders for spot and forward orders, executed by FX Trade Server. The FX Trade Server, in turn, converts the trades' foreign currency amounts into U.S. dollars. The FX Order Server provides for varying degrees of automatic and manual leave orders and uses the Rate Server to track and match a specific leave order's desired rate. Further, Payment Order Server (104) handles bank-to-bank money orders and allows the creation of an FX transaction out of a foreign payment. However, as Potter is designed to accept a single type of transactions at a time, there is no need to separate the transactions into two groups, a first group of transactions “not

requiring a foreign exchange operation” and a second group of transactions “requiring a foreign exchange operation.”

The Examiner asserted that Applicants relied upon features not recited in the claims, i.e., separates the transactions into those requiring foreign exchange operation and those not requiring foreign exchange operation. Final Office Action at 5. Applicants respectfully disagree.

Applicants note that claim 1 explicitly recites that the first processor receives a bulk file containing a plurality of funds transfer transactions. Claim 1 then recites that the first processor performs the function of “grouping the plurality of fund transfer transactions into fund transfer transactions requiring a foreign exchange operation, denoted as foreign exchange funds transfer transactions, and funds transfer transactions not requiring a foreign exchange operation, denoted as same currency funds transfer transactions.” Claim 6 recites similar language. Applicants assert that, in this instance, that as part of its “grouping” function, the first processor must separate the different types of transactions from the bulk file received by the first processor. Thus, Applicants have argued for the patentability of the pending claims based only on the limitations contained in the claims.

Independent claims 1 and 6 each recite limitations not anticipated by Potter, the only reference cited against them. Because each of the independent claims are patentable, the Office should also allow their dependent claims as well.

For the reasons discussed above, the Examiner has failed to set forth a prima facie case of anticipation in the present application. As such, Applicant

Application No.: 09/438,590

Docket No.: J2167.0125/P125


respectfully submits that the pending claims are not anticipated in light of the cited reference and are in condition for immediate allowance.

#### IX. CLAIMS INVOLVED IN THE APPEAL

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A are the same as those originally filed as Applicants have not amended the claims.

Dated: October 1, 2004

Respectfully submitted,



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## **APPENDIX A**

### **Claims Involved in the Appeal of Application Serial No. 09/438,590**

1. (Original) A system for processing funds transfer transactions from a customer of a financial institution, the system comprising:

a first processor receiving a bulk file from the customer, the bulk file containing a plurality of funds transfer transactions, the first processor grouping the plurality of funds transfer transactions into funds transfer transactions requiring a foreign exchange operation, denoted as foreign exchange funds transfer transactions, and funds transfer transactions not requiring a foreign exchange operation, denoted as same currency funds transfer transactions;

a second processor coupled to the first processor, the second processor receiving the same currency funds transfer transactions not requiring a foreign exchange operation from the first processor, the second processor generating first funds transfer instructions in response to the same currency funds transfer transactions;

a funds transfer processor coupled to the second processor, the funds transfer processor receiving the first funds transfer instructions from the second processor and executing the received first funds transfer instructions by transferring funds to a funds transfer processor of another financial institution; and

a trading processor coupled to the first processor, the trading processor receiving the foreign exchange funds transfer transactions from the first processor, the trading processor executing a foreign exchange operation in response to the received foreign exchange funds transfer transactions.

2. (Original) The system according to claim 1, wherein:  
the trading processor is coupled to the second processor,  
the trading processor forwarding to the second processor the foreign exchange funds transfer transactions and funds resulting from the foreign exchange operation,  
the second processor generating second funds transfer instructions in response to the foreign exchange funds transfer transactions and funds resulting from the foreign exchange operation, and  
the funds transfer processor receiving the second funds transfer instructions from the second processor and executing the received second funds transfer instructions by transferring funds to a funds transfer processor of another financial institution.
3. (Original) The system according to claim 1, further comprising:  
a link coupling the first processor to a system of the customer, wherein the customer system transmits the bulk file to the first processor.
4. (Original) The system according to claim 3, further comprising:  
a firewall disposed in the link coupling the first processor to the customer system.
5. (Original) The system according to claim 1, further comprising:  
a market link from the trading processor to a foreign exchange market, wherein the trading processor receives real time foreign exchange rates over the link.
6. (Original) A method for processing funds transfer transactions from a customer of a financial institution, the method comprising the steps of:

receiving a bulk file from the customer, the bulk file containing a plurality of funds transfer transactions;

grouping the plurality of funds transfer transactions into funds transfer transactions requiring a foreign exchange operation, denoted as foreign exchange funds transfer transactions, and funds transfer transactions not requiring a foreign exchange operation, denoted as same currency funds transfer transactions;

executing a foreign exchange operation in response to the foreign exchange funds transfer transactions to thereby generate available funds; and

settling the foreign exchange funds transfer transactions using the available funds.

7. (Original) The method according to claim 6, further comprising the steps of:

generating funds transfer instructions in response to the same currency funds transfer transactions; and

settling the same currency funds transfer transactions in response the funds transfer instructions.

8. (Original) The method according to claim 6, further comprising the step of:

separating the received bulk file into its component funds transfer transactions, the component funds transfer transactions including the foreign exchange funds transfer transactions and the same currency funds transfer transactions.

9. (Original) The method according to claim 6, further comprising the step of sending an acknowledgments to the customer upon receipt of the bulk file and upon the settlement of the funds transfer transactions.

10. (Original) The method according to claim 6, further comprising the step of grouping the foreign exchange funds transfer transactions into batches according a market in which the foreign exchange operation is to take place.

11. (Original) The method according to claim 10, further comprising the step of validating the format and contents of the batches.

12. (Original) The method according to claim 11, further comprising the step of validating the format and contents of the foreign exchange funds transfer transactions contained in the batches.

13. (Original) The method according to claim 10, further comprising the step of aggregating the foreign exchange funds transfer transactions contained in the batches according to a currency of the foreign exchange operation.